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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,876	01/29/2002	Taiji Sasage	1614.1211	2384

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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,876	<b>Applicant(s)</b> SASAGE ET AL.	
	<b>Examiner</b> Ponnoreay Pich	<b>Art Unit</b> 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/2006 has been entered. Claims 1-11 are pending. Any well known art statements made in the prior office action not specifically and adequately traversed are taken as admittance of prior art as per MPEP 2144.03.

### ***Response to Amendment and Arguments***

Applicant's amendments have been fully considered. Applicant's arguments were also fully considered, but are moot in view of new rejections presented below. It is noted that applicant submitted arguments with regards to how the prior art of record, Paul, does not meet certain limitations now amended onto the pending claims. See below for further explanation on how Paul or Paul in view of other references meets all the limitations recited in the pending claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,052,709) in view of Tarbotton et al (US 6,757,830).

**Claims 1 and 4:**

Paul teaches:

1. Registering a second address as a receiver address in an address table for unwanted mail, i.e. spam, detection (col 4, lines 35-55). *One can consider the address table as either the places the spam probe email is posted or the place processor 104 stores the spam probe address. The second address is the spam probe email address.*
2. Determining whether a first address indicated by an electronic mail transmitted from a client through the network indicates the second address recorded in the address table for unwanted mail detection (col 4, line 47-col 5, line 9 and Fig 7, item 703), the first address being registered in an address book of the client (col 1, lines 61-65 and col 4, lines 18-34). *Note that the sender of spam mail/the computer from which mail is sent is a client. Whether or not the identity of the sender is known is immaterial to a sender being a client. In the cited portions, Paul discloses addresses in spam mailing lists. Any of the addresses on such a list, i.e. address book of a client, is a first address.*
3. Storing information concerning the electronic mail as unwanted mail information in an unwanted mail information table in response to when the first address of the

electronic mail indicating the second address (col 5, lines 1-32; col 5, line 56-col 6, line 16; and Fig 8, items 804-806).

4. Suppressing transmission of any electronic mail that includes the unwanted mail (col 6, line 64-col 7, line 1).

Paul does not teach that unwanted mail is virus mail. However, Tarbotton discloses that unwanted mail includes not only spam, but also virus mail (col 1, lines 13-30). At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Paul's invention according to the limitations recited in claims 1 and 4 by modifying the invention so that it is used to not only protect against spam emails, but also virus emails. One skilled would have been motivated to do so because as evidenced by Tarbotton's teachings, both spam and virus emails contain unwanted properties. Use of Paul's teachings would allow Tarbotton to better detect email messages that contain one or more unwanted properties as per Tarbotton's objective (col 1, lines 63-67).

#### **Claims 2 and 5:**

Paul further discloses detection of unwanted mail properties to at least one predetermined report address, i.e. processor 104, in response to the first address indicating the second address (col 4, lines 47-56). Paul does not disclose unwanted mail properties detection being mail virus detection. However, Tarbotton discloses unwanted mail properties detection being mail virus detection (col 1, lines 13-30). As such, the limitation recited in claims 2 and 5 are obvious to Paul and Tarbotton's

combination invention. One skilled would have been motivated to combine the two teachings for the same reasons given in claims 1 and 4.

**Claim 8:**

Paul further discloses wherein the unwanted mail properties indicates one or more values of a sender electronic mail address, a data size, a title, or any combination thereof, which are shown in the electronic mail indicating the second address (col 5, lines 10-20). The unwanted mail properties being mail virus information is disclosed by Tarbotton (col 1, lines 13-30), thus the limitation further recited in claim 8 is obvious to the combination invention of Paul and Tarbotton.

**Claim 7:**

Paul discloses:

1. Detecting an electronic mail as having unwanted mail properties in response to determining that a first address of an electronic mail transmitted from a client corresponds to a second address recorded in an address table for unwanted mail properties detection (col 1, line 61-col 2, line 24; col 4, line 47-col 5, line 9; and Fig 7, item 703), the first address being registered in an address book of the client (col 1, lines 61-65 and col 4, lines 18-34).
2. Suppressing transmission of the electronic mail (col 6, line 64-col 7, line 1).

Paul does not disclose the unwanted mail properties being virus infection. However, Tarbotton discloses virus infection being unwanted mail properties (col 1, lines 13-30). At the time applicant's invention was made, it would have been obvious to

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one skilled in the art to combine the teachings of Paul and Tarbotton according to the limitations recited in claim 7. One skilled would have been motivated to combine the teachings for the same reasons given in claims 1 and 4.

**Claim 9:**

Paul further discloses storing information corresponding to the electronic mail as unwanted mail properties information in an unwanted mail properties information table in response to detecting the electronic mail as having unwanted mail properties (col 5, lines 1-32; col 5, line 56-col 6, line 16; and Fig 8, items 804-806). Paul does not disclose the unwanted mail properties information being virus information, however, the limitation is obvious to Paul and Tarbotton's combination invention as it is disclosed by Tarbotton (col 1, lines 13-30). One skilled would have been motivated to combine the two teachings for the reasons discussed above.

**Claim 10:**

Paul discloses suppressing transmission of any electronic mail that includes the unwanted mail properties in response to detecting the electronic mail as being infected with unwanted mail properties (col 6, line 64-col 7, line 1). Paul does not disclose the unwanted mail properties being a virus. However, the limitation is obvious to Paul and Tarbotton's combination invention as Tarbotton discloses unwanted mail properties being a virus (col 1, lines 13-30). One skilled would have been motivated to combine the two teachings for the reasons discussed above.

**Claim 11:**

Paul further discloses reporting the unwanted mail properties detection to at least one predetermined report address in response to detecting the electronic mail as containing unwanted mail properties (col 4, lines 47-56). Note that any electronic mail where the first address is the same as the second address is assumed to contain unwanted mail properties. Paul does not explicitly disclose unwanted mail properties being virus infection. However, the limitation recited in claim 11 is obvious to Paul and Tarbotton's combination invention because Tarbotton discloses viruses and infection of email messages by viruses as being unwanted mail properties (col 1, lines 13-30). One skilled would have been motivated to combine the two teachings for the reasons discussed above.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,052,709) in view of Tarbotton et al (US 6,757,830) and further in view of common knowledge in the art and Ji et al (US 5,889,943).

**Claims 3 and 6:**

As per claims 3 and 6, Paul and Tarbotton does not explicitly disclose compressing the electronic mail having the first address indicating the second address; and attaching the compressed electronic mail to a report electronic mail for reporting the mail virus detection, and reporting the mail virus detection by sending the report electronic mail to at least one predetermined address.



However, as stated in a prior office action, compressing electronic mail before sending it was well known in the art at the time applicant's invention was made.

Further, Ji discloses attaching (virus) electronic mail to a report electronic mail for reporting mail virus detection, and reporting the mail virus detection by sending the report electronic mail to at least one predetermined address (col 20, lines 40-63).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Paul and Tarbotton's combination invention according to the limitations recited in claims 3 and 6 in light of the above teachings by common knowledge in the art and Ji. One skilled would have been motivated to send a report electronic mail to at least one predetermined address as per Ji's teachings based upon a first address indicating a second address because if the first address indicates a second address, there is a high possibility that the mail is infected with a virus. Sending it to a predetermined address, i.e. administrator, to analyze allows the virus to be analyzed and countermeasures to the virus developed. One skilled would have been motivated to compress the mail sent to the predetermined address because it would allow the mail to be sent faster and the mail to take up less storage space in the receiver's/administrator's system. Compressing the virus infected email would also help prevent accidentally executing virus code contained in the email message.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich  
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Art Unit 2135



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